

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Stomp et al.
Application No.: 10/677,441
Filed: October 2, 2003
For: *Genetically Engineered Duckweed*

Confirmation No.: 9042
Group Art Unit: 1638
Examiner: Li Zheng

Date: June 3, 2008

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10/16/2008

APPELLANTS' REPLY BRIEF ON APPEAL UNDER 37 C.F.R. §41.41

Sir:

This Reply Brief is filed in response to the Examiner's Answer mailed April 3, 2008.

I. Part VII of the Examiner's Answer (page 3).

The Examiner states "[a]ppellants brief does not include a statement regarding the grouping of the claims therefore claims 1-40 stand or fall together." Appellants note that a statement regarding grouping of claims is no longer required (*See, Federal Register* Vol. 69, No. 155, page 49962). Therefore, no conclusion can be drawn by the absence of such a statement.

II. Part X of the Examiner's Answer (Grounds of Rejection) (page 3-4).

The Examiner states that he confirms that claims 1-17 of the U.S. Patent No. 6,815,184 were intended to be referred to in this double patenting rejection. Appellants note that in the teleconference between Appellants' representatives and the Examiner it was stated that the rejection should have recited claims 1 and 17 of the '184 patent rather than claims 1 and 22-25 because claims 22-25 did not exist in the '184 patent. Therefore, Appellants believe that it is claims 1 and 17 of the '184 patent and not claims 1 through 17 that were to be under consideration in this rejection.

III. The Examiner's Answer – Response to Arguments (starting at Page 6)

Appellants will refrain here from addressing all of the deficiencies with the pending rejections again and, instead, in the interest of brevity, Appellants hereby incorporate herein the arguments set out in Appellants' Brief on Appeal as if set forth herein in their entirety. Accordingly, Appellants will only address new arguments made in the Examiner's Answer.

A. Rationales for Making a Double Patenting Rejection.

The Examiner's Answer states that Appellants narrowly interpret the purpose for a double patenting rejection and argues that the concern of possible harassment by multiple assignees is a further rationale for a nonstatutory double patenting rejection. (Examiner's Answer, page 6). Applicants are fully aware of this additional rationale and it is addressed in the Appeal Brief on pages 6-7.

As discussed in the Appeal Brief and in further detail herein, Appellants assert that this rationale is not applicable to the present application. The courts have addressed harassment by multiple assignees in the context of commonly owned patents that might subsequently be assigned or transferred to different parties. Thus, the Patent Office and the courts have addressed this concern by requiring that common ownership be maintained through the use of a non-alienation clause included in a terminal disclaimer.

The common ownership provision of a terminal disclaimer was addressed in *In re Van Ornum*, where it stated that "[t]his provision would prevent harassment of an alleged infringer by multiple parties due to subsequent different ownership of multiple patents granted as the result of filing a terminal disclaimer to overcome a double patenting rejection" (686 F.2d at 945, 214 U.S.P.Q at 768; emphasis added). The court in *In re Van Ornum* further stated "[w]hen a terminal disclaimer causes two patents to expire together(.) a situation is created which is tantamount for all practical purposes to having all the claims in one patent. Obviously, that thought contemplates common ownership of the two patents, which remains common throughout the life of the patents" (686 F.2d at 948, 214 U.S.P.Q at 770; emphasis added).

In *Chisom on Patents*, a discussion of harassment by multiple assignees states that "[e]ven though both patents are issued to the same patentee or assignee, it is possible that ownership of the two would be divided by later transfer and assignments" (*Chisom on Patents*,

Donald S. Chisom, Chapter 9, section 9.04[2][b][ii]; emphasis added). Since a terminal disclaimer can only be filed where the patents or applications are commonly owned, the requirement that a terminal disclaimer include a non-alienation clause dictates that there is common ownership.

Turning to the present case, with regard to the '184 patent and the application at issue, these two inventions were never commonly owned and the inventors in each case were by law required to assign to different owners (employers). At no time were these two inventions commonly owned. Thus, Appellants respectfully submit that the issue of harassment by multiple assignees does not apply to this case.

The Examiner asserts that Appellants appear to be arguing that common ownership is a requirement for making an obviousness-type double patenting rejection. Appellants are not arguing that such a requirement is needed to make an obviousness-type double patenting rejection but rather that it is a necessary component behind the harassment rationale being put forth by the Examiner for making this double patenting rejection. Appellants assert that the harassment rationale does not apply to the present case because there was never any common ownership and therefore never any concern for future division of ownership as it has always been divided.

The Examiner is directed to 804.03 for guidance when non-commonly owned applications may be rejected on the ground of double patenting. MPEP 804.03 I. states that “[c]laims may also be rejected on the grounds of nonstatutory double patenting in certain non-commonly owned applications that claim inventions resulting from activities undertaken with the scope of a joint research agreement as defined in 35 U.S.C. 103(c)(3). This prevents the parties to the joint research agreement from obtaining two or more patents with different expiration dates covering nearly identical subject matter.” The MPEP goes further, stating that:

Pursuant to the CREATE Act, non-commonly owned applications or patents that are subject to a joint research agreement may be treated as if they are “commonly owned,” i.e., owned or subject to assignment by the same person, for the purposes of determining obviousness if certain conditions are met. See 35 U.S.C. 103(c)(2). The term “joint research agreement” means a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field

of the claimed invention. See 35 U.S.C. 103(c)(3). See also MPEP §706.02(1)(2).

MPEP 804.03 II. B. As Appellants have informed the Examiner, the claimed inventions in the '184 patent and the present application did not result from activities undertaken within the scope of a joint research agreement. The rejection of non-commonly owned applications for double patenting on this basis simply does not apply.

Accordingly, Appellants respectfully submit that neither rationale proposed for imposing a double patenting rejection, the unjustified timewise extension of the right to exclude nor the prevention of harassment by multiple assignees, is applicable to the present application in view of the '184 patent.

Further as a result of the divided ownership between the '184 patent and the present application, the anomaly presented by this rejection is that the filing of the terminal disclaimer is not an option available to the assignee of the present application. This is not the situation addressed by the courts and the BPAI where the assignee owns both applications and is simply refusing to file a terminal disclaimer. (*See, e.g., In re Berg*, 140 F.3d 1428, 46 U.S.P.Q.2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 U.S.P.Q.2d 2010 (Fed. Cir. 1993); *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 765 F.Supp. 121 (S.D.N.Y. 1991); *Ex parte Krueger et al.*, Appeal No. 95-4633 (BPAI);); *Ex parte Haluska*, Appeal No.1996-3816 (BPAI); *Ex parte Wachtler et al.*, 97-1278 (BPAI); *Ex parte Sorenson*, 1997-3047 (BPAI)). In such cases when a double patenting rejection has been raised and the assignee has owned both applications and or patents at issue, the assignee has been able to overcome the rejection with the submission of a Terminal Disclaimer. But in the case of this particular rejection, as has been repeatedly pointed out, the present application and the '184 patent are not commonly owned and thus, the filing of a terminal disclaimer to overcome is double patenting rejection does not present itself as an option for overcoming this rejection.

B. Two-way test.

With regard to the two-way test, the Examiner states that Appellants do not meet the initial burden to show why Appellants could not have filed all claims in a single application or

that there is administrative delay during the prosecution of the instant application. (Examiner's Answer, page 10; emphasis added).

As an initial point, Appellants disagree that the only relevant administrative delay is delay that occurred during the prosecution of the "instant application." Appellants submit that the prosecution of the entire lines of cases leading to and including the present application must be considered. Appellants further submit that delay includes delay caused by the multiple restriction requirements imposed in the parent application and in each child application. Such restriction requirements result in the need to file additional divisional applications in prosecute to cover each of the inventions disclosed in the original application, thus, setting up the possibility of a patent issuing from a later filed application before the patent issues from a divisional application claiming priority from the earlier filed application.

Further, Appellants note that the issue of delay encompasses the larger issue of control of prosecution by the patentee. Thus, when the courts and The Board of Patent Appeals and Interferences (BPAP) have found an applicant in control of prosecution in a double patenting setting, it has always been in the situation where the applicant/assignee had control over prosecution of each of the applications/patent at issue. (*See, In re Emert*, 124 F.3d 1458, 1461; 44 U.S.P.Q.2d 1149 (Fed. Cir. 1997) (concluding that "because Emert orchestrated the rate of prosecution for the two applications, this court applies a one-way analysis"); *see also, In re Berg*, 140 F.3d 1428, 46 U.S.P.Q.2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 U.S.P.Q.2d 2010 (Fed. Cir. 1993); *Ex parte Haluska*, Appeal No.1996-3816 (BPAP); *Ex parte Krueger et al.*, Appeal No. 95-4633 (BPAP).

In contrast to these situations, the assignee of the present application had no control over the filing or prosecution of the application that matured into the '184 patent. Furthermore, even though there was a single common inventor, this inventor was working under the auspices of a different assignee/owner who controlled the prosecution of the later filed application that matured into the '184 patent. The single common inventor was not in control of the prosecution of both or even one of these cases.

With regard to inclusion of the claims of the '184 patent in the present application, the Examiner states that it was well known in the art that α -2b-interferon could be used to treat diseases and that the sequence for human α -2b-interferon was available and thus could have been

included in the present application. The Examiner further states that while the applications are owned and prosecuted by different assignees, they still share one common inventor who has the knowledge of both applications.

It is important to note that while there was a single common inventor, different inventive entities were involved in each case. The assumption the Examiner is making is that the single common inventor conceived of all of the aspects of both inventions, a leap that simply cannot be made. The Examiner also appears to have concluded that the sole difference between the claims of the present application and that of the '184 patent is the inclusion of α -2b-interferon in the claims of the '184 patent.

The courts and the BPAI have held that the claims of a later filed application could have been included in the earlier filed application, when the earlier filed application was found to support the later filed claims. For example, the court in *In re Berg* stated that

...the specifications of the Berg application and of the '916 patent are identical; the two disclosures are almost exactly alike. The invention described in claim 1 of the '916 patent, therefore, is anything but "totally separate" from that of the Berg application. In fact, the preferred embodiment of practicing the invention disclosed in the written description of both the application and the '916 patent is claimed in claim 1 of the '916 patent. In addition, both the '916 patent and the application list the same inventive entity, i.e., the same four inventors. ... Finally, unlike *Borah*, the inventions disclosed in both sets of claims had been completed before either application was filed. *In re Berg*, 140 F.3d 1428, 1434, 46 U.S.P.Q.2d 1226, 1231 (Fed. Cir. 1998) (emphasis added).

The court in *In re Berg*, further stated that "Berg deliberately chose to file simultaneously two applications containing almost identical disclosures, with each disclosure supporting both sets of claims. Berg therefore took the risk that it would be required terminally to disclaim." 140 F.3d 1437, 46 U.S.P.Q.2d 1226, 1233. (See also, *In re Goodman*, 11 F.3d 1046, 29 U.S.P.Q.2d 2010 (Fed. Cir. 1993); *In re Bratt*, 937 F.2d 589, 19 U.S.P.Q.2d 1289 (Fed. Cir. 1991)).

In contrast to *In re Berg*, the disclosure of the present application is **not** identical to that of the '184 patent. Nor could the claims of the '184 patent have been supported by the disclosure of the present application. These applications were not filed simultaneously but rather three years apart by two separate and unrelated entities. In addition to α -2b-interferon, the claims of

the '184 patent include signal peptides, specific translation initiation codons, and specific sequences that are not found in the present application. Clearly, the '184 patent is an "improvement patent" disclosing aspects that the U.S. Patent Office considered novel and non-obvious over the disclosure of the PCT counterpart of the present application (PCT/US98/16683; WO 99/07210). There is no basis upon which it can be assumed that the '184 invention was completed or even conceived of at the time the present application was filed. Further, there is no basis for an assumption that the single common inventor was responsible for all of the claimed aspects of the '184 patent such that they could have been included in the present application filed three years earlier. These inventions were conceived of and carried out at different times by different inventors under the auspices of different assignees/owners. Additionally, in contrast to *In re Berg*, the assignee/owner of the present application had no control over the filing and prosecution of the later filed application, and thus did not choose to file the application that matured into the '184 patent. Furthermore, unlike *In re Berg*, the option to file a terminal disclaimer is not available to the assignee/owner of the present invention.

Accordingly, Appellants reassert that it is unfair to penalize an entity with an earlier filed application by allowing a later file application assigned to a completely different entity to block the earlier filed application simply because the first entity employed an inventor who decided to pursue a career with the second entity and invent improvements to the first entity's invention.

As it stands, the USPTO's position represented by the present double patenting rejection achieves absurd results. Since the application and patent at issue were filed as two separate inventions under the auspices of two separate entities, a terminal disclaimer cannot be filed to overcome the rejection. Thus, in this case, the senior party would appear to be blocked from obtaining a patent by a junior party. If this rejection is maintained, the only way to achieve any fairness is to apply the two-way obviousness test. Therefore, Appellants contend that if a double patenting rejection is found to be proper then the appropriate test for such a rejection is the two-way obviousness test.

Accordingly, Appellants respectfully submit that the obviousness-type double patenting rejections of Claims 1-40 of the present application should be reversed for the reasons discussed herein and in Appellants' Brief on Appeal.

IV. Conclusion

For the reasons set forth above and in Appellants' Brief on Appeal, Appellant requests reversal of the rejections of the claims, allowance of the claims, and passing of the application to issuance.

No fee is believed due. However, the Commissioner is hereby authorized to charge any deficiency, or credit any refund to our Deposit Account No. 50-0220.

Respectfully submitted,



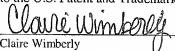
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